

US.Pat.Apl: 10/694,835

Docket 221-46US

Remarks,
responsive to O/A dated 17 March 2005

Please enter the amendments to the claims as submitted herewith. Basis for new claim 16 is found in paragraph [0043] of the specification. Basis for new claim 17 is found in paragraph [005].

1. Re: the 35 USC 112, 2nd §, rejection of claim 4.

1.1 First, the rejection of claim 4 based on "fleshy".

The PTO alleges (again) that it is unclear as to what constitutes a "fleshy" surface. We point out (again) that claim 4 does not recite the expression *fleshy surface*.

1.2 Second, the rejection of claim 4 based on "thick".

Claim 4 recites: *having foliage that is characterised as thick and fleshy, and as having a waxy surface*.

We note that, in our response dated 03-January-2005, we supplied a carefully detailed explanation as to why the expression *foliage that is characterised as thick and fleshy, and as having a waxy surface* is in fact perfectly definitive of the invention as claimed in claim 4. Our explanation touched on how patent claims are to be construed, on when comparative terms in claims can be regarded as definitive, on how to interpret the claims in the context of the specification, etc.

Our carefully prepared arguments are answered by the PTO, in its *Response to Arguments* section of the 17 March 2005 O/A, simply with: *It is the examiners opinion that the specification is insufficient for one skilled in the art to know what would constitute a thick, fleshy waxy plant*.

Consider what the PTO would do if we replied to a properly-presented 2nd § of 35 USC 112 rejection simply by asserting that *It is our opinion that the specification is sufficient for one skilled in the art to know what would constitute* a procedure that falls within the scope of claim 4. The MPEP makes it clear that the PTO would not regard such a bare assertion as adequately responsive. Equally, the corresponding bare unsupported assertion from the PTO, that *It is the examiners opinion that the specification is sufficient for one skilled in the art to know what would constitute a thick, fleshy waxy plant* is likewise inadequate.

If the PTO decides to continue its '112 rejection of claim 4, we ask to be provided with a careful, detailed, reasoned, explanation of the support or basis for the allegation that the skilled person would not be able to determine the scope of claim 4 with a reasonable degree of certainty, having perused our specification, explaining particularly why the PTO is able to ignore the points we made in our letter filed 03 January 2005. The PTO might inform us which sections of the MPEP it is relying on, for example.

1.3 We point out that claim 4 does not recite *a thick, fleshy waxy plant*. Therefore, the PTO's Response to Arguments is irrelevant. That is to say, it is irrelevant whether our specification is insufficient for the skilled person to know what would constitute a thick, fleshy waxy plant.

Perhaps the PTO made a mistake here, and meant to say something else. However, it is not up to us to try to speculate or guess what the PTO might have meant to allege. For our part, it is our position that claim 4 is perfectly well supported by our specification, as we carefully explained, in detail, in our letter filed 03 January 2005. We do not concede that our specification is insufficient in any material respect.

2. We also note the PTO position that *The specification gives two examples a Hoya and a Peperomia, neither of which would be characterised as being fleshy or necessarily thick*.

We feel this assertion is mistaken. But in any case, we cannot see why the PTO would introduce this point as a response to our arguments that our specification is sufficient for the skilled person to determine the scope of claim 4.

2.1. The claim 4 rejection is on the basis (a) that claim 4 is indefinite as to what range of thickness is specified by "thick" or (b) that claim 4 is unclear as to what constitutes a "fleshy" surface. The PTO's Response to Arguments contends that neither a Hoya nor a Peperomia would be characterized as being fleshy or necessarily thick.

We point out that claim 4 does not recite the Hoya or the Peperomia. Therefore, we cannot see how the fact (if it were a fact) that these plants cannot be characterised as *being fleshy or necessarily thick* would be considered by the skilled person as being relevant to determining the scope of claim 4. The PTO has not explained how the skilled person might find it so.

If the PTO is going to reject claim 4 on the grounds that claim 4 is so worded that the skilled person cannot determine the scope of claim 4, we are entitled to have the PTO direct its reasons for rejection to the words we actually recited in claim 4. When the PTO rejects an applicant's patent application, it should not be left to the applicant to try to guess what the PTO might have had in mind.

2.2. As far as we are concerned, the words that actually are recited in claim 4 do apply to the Hoya and Peperomia.

We qualify this statement as follows. Suppose it is true that there are some varieties or species of Hoya or Peperomia that do not have foliage that would be characterised (by the skilled person) as thick and fleshy and as having a waxy surface. Clearly, those varieties or species of Hoya or Peperomia would not fall within the scope of claim 4.

On the other hand, of course there certainly are some species or varieties included within the generic terms Hoya and Peperomia that can be so categorised, and those species and varieties do fall within the scope of claim 4.

That is to say, we should not be taken to be asserting, necessarily, that every variety and species of Hoya and Peperomia fall within the scope of claim 4. What we do assert is that the skilled person can determine, from the words actually recited in claim 4, as construed in the light of the

whole disclosure, whether this or that species or variety of Hoya or Peperomia does or does not fall within the scope of claim 4 -- perhaps not absolutely, but at any rate to the reasonable degree of certainty that is required under the 2nd § of 35 USC 112.

3. Re: Priority Claim.

The examiner rejects claim 1 and the rest of the claims under 35 USC 103, based on a combination of the patent publications EP-1,367,334 and US-5,433,923 (Wolverton).

Patent publication EP-1,367,334 was published 03-December-2003.

The examiner alleges that the claims as now examined are not entitled to the priority date of 30-October-2002 (from GB-02/25230.2), and accordingly the effective filing date for the claims is 29-October-2003.

We do not concede this, i.e that the effective filing date of the claims is the date of filing the instant application, namely 29-October-2003. However, the point is not relevant, for the following reason, namely: even if the effective filing date of our claims really is 29-October-2003, that date still pre-dates the 03-December-2003 publication date of the cited EP-1,367,334.

We feel the PO has simply made a mistake over the publication date of EP-1,367,334. It is our position that EP-1,367,334 was not published early enough to be available for a rejection under 35 USC 103(a), and that the rejection must fall for that reason.


4. Re: prior publication NL-1,001,236 (Coumans, 1996).

The PTO has not made any rejection of the present patent application based on Coumans. However, we request that some amendments be entered in claim 1, which we feel now properly distinguish claim 1 inventively from that publication.

We also note that the technology described in paragraph [0046] now does not fall within the scope of (amended) claim 1.

5. In our view, this patent application is now in order for allowance, and we look forward to receiving notification of same.

Submitted by:


Anthony Asquith
Regn 32373
Agent for the Applicant

Encl: - amended claims (4 pages)